REMARKS

Applicant respectfully requests entry of the foregoing amendments and reconsideration of the application in view of the amendments above and the remarks below. Claims 1, 3-5, 7-9, 12, 15, 16, and 17 have been amended, and claims 1-20 remain pending in the application. Claims 1, 10, and 16 are independent claims.

Applicant respectfully submits that the foregoing amendments are relatively minor and, therefore, do not present any new issues for consideration or require a new search by the Examiner. Thus, Applicant respectfully submits that the foregoing amendments should be entered without objection.

Additionally, Applicant notes that the foregoing amendments have been made as a matter of administrative convenience, and are not intended to surrender subject matter to the public. Additionally, Applicant does not acquiesce to the Examiner's characterization of the claimed invention or the applied references. Accordingly, Applicant reserves the right to pursue claims of different scope, including subject matter in the claims prior to the above amendments.

Status of Claims

Applicant notes that there is a discrepancy regarding the status of the outstanding Office Action in the Office Action itself (i.e., the Office Action Summary and page 14 state that the Office Action is final, while page 2 of the Office Action states that the Office Action is "a non-final first office action"). Examiner Robinson-Boyce has confirmed to the undersigned that the outstanding Office Action is a final Office Action.

Claims 1-10 and 12-20 are patentable under 35 U.S.C. § 103

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,024 to Shkedy (hereinafter "*Shkedy*") in view of U.S. Patent No. 6,070,145 to Pinsley et al. (hereinafter "*Pinsley*"). Applicant respectfully traverses this rejection for the reasons set forth below.

Independent claim 1

Independent claim 1, as amended, recites a processor-readable medium comprising code representing instructions to cause a processor to: receive transaction information related to a transaction, including consumer information and merchant information; compare consumer information and merchant information with predetermined consumer information and predetermined merchant information, respectively, and determine whether to invite the consumer to complete a survey related to the transaction "*based at least partially on the comparison of the consumer information and the comparison of the merchant information.*"

With regard to independent claim 1, the Examiner has admitted that *Shkedy* fails to disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction, for which the Examiner relies on *Pinsley*. (Final Office Action at 3.) The Examiner argues that selecting a random user (e.g., every Nth visitor), as taught by *Pinsley*, can be interpreted as making a determination of whether to invite a consumer to complete a survey based at least partially on consumer information. (Final Office Action at 11.) Although Applicant disagrees with this over-expansive reading of *Pinsley*, claim 1 has been amended for the sake of administrative convenience.

Applicant respectfully submits that *Pinsley* does not disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction "*based at least partially on the comparison of the consumer information and the comparison of the merchant information*," as recited by independent claim 1.

Rather, *Pinsley*, at best, discloses a system that selects every Nth visitor to be invited to complete a survey, based on a predetermined value of N stored as "offering criteria." (Col. 2, lines 26-42.) *Pinsley* also discloses that a user is invited to complete a survey at the conclusion of a transaction based on "random or statistically driven pseudo-random criteria." (Col. 4, lines 9-13.) There is no disclosure or suggestion in *Pinsley* of determining whether to invite a consumer to complete a survey based on any comparisons. Additionally, there is no disclosure or suggestion in *Pinsley* of making such a determination based on any merchant information or comparisons of merchant information.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 1 be withdrawn. Additionally, for at least the same reasons,

Applicant respectfully requests that the rejection of claims 2-9, which depend from independent claim 1, be withdrawn.

Independent claim 10

Independent claim 10 recites a processor-readable medium storing code representing instructions to cause a processor to perform a process, which includes, among other features, "instructions to cause a processor to ... determine, *using the historical consumer information*, whether to collect survey information from the consumer in the transaction."

With regard to independent claim 10, the Examiner has admitted that *Shkedy* fails to disclose or suggest determining whether to collect survey information at all. (Final Office Action at 6.) Although the Examiner has stated that *Shkedy* performs some type of determining using historical consumer information (pointing to the "credit history" disclosed in col. 10 of that document), Applicant respectfully submits that there is no discussion of making any determination using historical consumer information. To the contrary, the selection cited by the Examiner merely states that data (e.g., "credit history" data) is maintained in a database.

The Examiner argues that it would be obvious to use the credit history of *Shkedy* to determine whether or not to collect survey information from a consumer using the system of *Pinsley*. (Final Office Action at 11-12.) As a rationale for this argument, the Examiner states that the "credit history" of *Shkedy* can be used as the "predetermined criteria" of *Pinsley*. A fair reading of *Pinsley*, however, reveals that the determination of whether to make an offer to participate in a survey is based on "random or statistically driven pseudo-random criteria" (col. 4, lines 11-13), by which the offer to participate is randomly offered to every Nth visitor. (Col. 2, lines 26-42.) The offer is not, however, based on any historical consumer information, as recited in independent claim 10. Indeed, *Pinsley* teaches away from the combination proposed by the Examiner, as the selection of every Nth visitor in *Pinsley* would conflict with any determination based on other information, such as historical consumer information, as recited in independent claim 10.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 10 be withdrawn. Additionally, for at least the same reasons, Applicant respectfully requests that the rejection of claims 12-15, which depend from independent claim 10, be withdrawn. Moreover, because *Kurland et al.*, which is used to reject

claim 11, does not remedy the deficiencies of *Shkedy* and *Pinsley* discussed above with respect to independent claim 10, from which it depends, Applicant respectfully requests that the rejection of claim 11 be withdrawn.

Independent claim 16

Independent claim 16 recites a system for collecting survey information relative to a transaction. The system includes a monitoring interface, a processor, and a participant interface. The processor is configured to analyze said transaction record relative to stored consumer information, and is "further configured to determine whether to solicit survey information from the consumer to the transaction *based at least partially on the transaction record and the stored consumer information.*"

Shkedy does not disclose determining whether to solicit survey information from a consumer, as the Examiner has admitted with regard to claims 1 and 10.[1]

Pinsley also does not disclose or suggest a processor configured to determine whether to solicit survey information *based at least partially on the transaction record and the stored consumer information.*

Rather, *Pinsley* discloses making an offer to participate in a survey at the conclusion of a transaction to every Nth visitor based on "random or statistically driven pseudo-random criteria," and not based on any transaction record. (Col. 2, lines 26-42, col. 4, lines 11-13.) Because an offer is made to every Nth visitor, there is no need to store consumer information or to use consumer information or a transaction record to determine whether to solicit survey information from a consumer.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 16 be withdrawn. Additionally, for at least the same reasons, Applicant respectfully requests that the rejection of claims 17-20, which depend from independent claim 16, be withdrawn.

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[1] The Examiner appears to have mistakenly cited a passage from *Pinsley* as if it were a passage from *Shkedy* on page 9 of the final Office Action.

<u>Lack of motivation to combine / teaching away of *Shkedy* and *Pinsley*</u>

There is no motivation to combine the teachings of *Shkedy* and *Pinsley*. The Examiner argues that the "references are combinable since they both disclose network-based systems for facilitating transactions between buyers or consumers and sellers or advertisers." (Final Office Action at 13).

Applicant respectfully submits, however, that *Pinsley* teaches away from the combination proposed by the Examiner. Specifically, as pointed out above, *Pinsley* is directed to making an offer to participate in a survey at the conclusion of a transaction to every Nth visitor based on "random or statistically driven pseudo-random criteria," and not based on any other information. (Col. 2, lines 26-42, col. 4, lines 11-13.) Thus, one of ordinary skill in the art would not be motivated to make such an offer based on other information (e.g., the credit history information of *Shkedy*), because to do so would render useless the random selection process disclosed by *Pinsley*.

Accordingly, for at least this additional reason, Applicant respectfully requests the withdrawal of the rejection of independent claims 1, 10, and 16, and their respective dependent claims.

Conclusion

All rejections having been addressed, Applicant respectfully submits that the present application is in condition for allowance, and earnestly solicits a Notice of Allowance, which is believed to be in order. Should the Examiner have any questions regarding this communication, or the application in general, she is invited to telephone the undersigned at 703-456-8108.
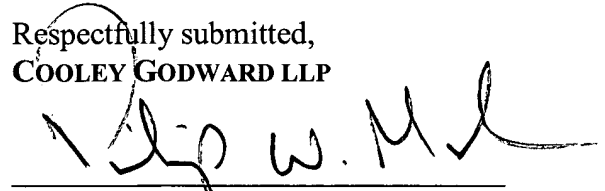
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R.§§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: <u>September 20, 2004</u>

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